

## **REMARKS**

Applicant wishes to thank the Examiner for the attention accorded to the instant application.

In this response, claims 3, 6 and 9-12 have been amended. Claims 1, 2, 4, 5, 7 and 8 are canceled. Specifically, two additional limitations have been added to independent claims 3, 6, and 9. One limitation is “the total number of cases being a number of times a number represented by an item of the retrieved data called the portable telephone set and was called by the portable telephone set”; support for this can be found in the specification on page 11, lines 3-5. The second limitation is “when the designated sequence of display is a sequence of greater number of times of utilization, the display sequence is also of the greater number of times of utilization”; support for this can be found in the specification on page 9, lines 11-14.

Claim 9 is further amended to delete the features of a CPU and a memory.

### **Summary of Telephone Interview with Examiner**

The Examiner had a telephone interview with the applicant on March 7, 2007, in which the Examiner provided specific information regarding the rejection of previously allowed claims 3, 6, and 9-12. Applicant appreciates the Examiner’s suggestions for amendments that add limitations in the claims to place them in position for allowance. As discussed above, applicant has amended the claims in accordance with the Examiner’s suggestions.

### **Rejection of Claims Under 35 U.S.C. §103**

The Examiner has rejected claims 3, 6, and 9-12 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,408,191 to Blanchard et al. (hereinafter “Blanchard”) in

view of U.S. Patent No. 6,320,943 to Borland and further in view of U.S. Patent No. 6,278,886 to Hwang. This rejection should be withdrawn based on the comments and remarks herein.

As discussed above, in a telephone interview, the Examiner suggested adding limitations to the independent claims to place them in position for allowance. Claims 3, 6, and 9 are amended to recite the additional limitation of “the total number of cases being a number of times a number represented by an item of the retrieved data called the portable telephone set and was called by the portable telephone set”. Neither Blanchard nor Borland nor Hwang disclose this feature, and the Examiner does not state otherwise.

Further, claims 3, 6, and 9 recite “when the designated sequence of display is a sequence of greater number of times of utilization, the display sequence is also of the greater number of times of utilization” to more clearly recite the relationship of the designated retrieval method (one of “data retrieved by a Japanese 50-kana sequence retrieval method, a kana affixing retrieval method, a group retrieval method or a telephone number inputting retrieval method”) and the display sequence. Neither Blanchard nor Borland nor Hwang disclose this relationship between the designated retrieval method and the display sequence, and the Examiner does not state otherwise.

It has been held by the courts that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. See, *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). As illustrated above, the hypothetical combination of Blanchard, Borland and Hwang does not disclose or suggest each and every feature of the present invention as recited in independent claims 3, 6, and 9. Thus *prima facie* obviousness has not been established. Accordingly, claims 3, 6, and 9 are distinguishable over the art of record in the application. Claim 10 depends from claim 3, claim 11 depends from claim 6, and claim 12

depends from claim 9, each incorporating all of the features of its base claim. Thus the dependent claims are patentable over the art of record in the application for at least the reasons that their base claims are patentable over the art of record in the application. Accordingly, withdrawal of this rejection is requested.

**Conclusion**

Applicant respectfully requests that the Examiner allow the Application since the rejected claims are canceled herein. Should the Examiner have any questions regarding this Amendment, or regarding the Application generally, the Examiner is invited to telephone the undersigned attorney.

Respectfully submitted,



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